

Notice of Allowability

Application No.

09/624,670

Applicant(s)

MUKERJI ET AL.

Examiner

Art Unit

Delia M. Ramirez

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 3/17/2004.
2. ☒ The allowed claim(s) is/are 1,3-5,8-24,47,52 and 53.
3. ☒ The drawings filed on 11 January 2002 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

Status of the Application

Claims 1, 3-47, 49-53 are pending.

Amendment of claims 50-53 in a communication filed on 3/17/2004 is acknowledged.

In a telephone conversation with Cheryl Becker on 4/5/2004, an agreement was reached to cancel claims 50-51 to place the application in condition for allowance.

In a telephone conversation with Cheryl Becker on 4/8/2004, an agreement was reached to cancel withdrawn claims 6-7, 25-46, 49 to place the application in condition for allowance.

Examiner's Amendment

1. An informal Examiner's amendment to the specification appears below. This amendment is to update the status of prior application(s) referenced in the first sentence of the specification (37 CFR 1.78).

2. In page 1, immediately after the title, please replace the paragraph corresponding to lines 3-8 with the following sentence:

The subject application is a continuation-in-part of U.S. patent application Serial No. 09/379,095 filed on August 23, 1999, now abandoned, which is a continuation-in-part of U.S. patent application Serial No. 09/145,828 filed on September 2, 1998, now U.S. Patent No. 6403348, both of which are herein incorporated in their entirety by reference.

3. An Examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

4. Authorization for this Examiner's amendment was given in a telephone interview with Cheryl Becker on 4/5/04 and 4/8/04:

5. Please cancel withdrawn claims 6-7, 25-46, and 49.

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6. Please cancel claims 50-51.

Reasons for Allowance

7. The following is an Examiner's statement of reasons for allowance. Although Tvrdik et al. (J. Cell Biol. 149(3):707-717, May 2000; cited in previous Office Actions) teaches a mouse nucleic acid comprising the entire sequence of SEQ ID NO: 5, in view of Applicant's declaration filed 4/15/2004 indicating that the claimed invention was conceived and reduced to practice prior to the publication of Tvrdik et al., this reference is no longer considered prior art. As such, the Examiner has found no teaching or suggestion in the prior art directed to the nucleic acids of SEQ ID NO: 5-6 or nucleic acids encoding the polypeptides of SEQ ID NO: 63-64, or variants thereof as encompassed by the claims. Therefore, claims 1, 3-5, 15, 47, 52-53 directed to the nucleic acids of SEQ ID NO: 5-6, or nucleic acids encoding the polypeptides of SEQ ID NO: 63-64, or variants thereof encompassed by the claims, and claims 8-14, 16-24 directed to a method of recombinantly producing the polypeptides encoded by the polynucleotides of SEQ ID NO: 5-6, or host cells comprising said polynucleotides, are allowable over the prior art of record.

8. Claims 1, 3-5, 8-24, 47, 52-53 are allowed.

9. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (571) 272-0938. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy can be reached on (571) 272-0928. Any inquiry of a general nature or

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relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Delia M. Ramirez, Ph.D.
Patent Examiner
Art Unit 1652

DR
April 15, 2004


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PRIMARY EXAMINER
GROUP 1652
1652